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REMARKS

TC 2800 MAIL ROOM

Claims 1-20 were considered in the Office Action of September 6, 2000. Claim 5 was rejected under 35 U.S.C. § 112, second paragraph. In addition, certain of the claims were rejected under 35 U.S.C. § 102(a) over Hathaway, U.S. Patent No. 4,099,211 ("Hathaway"); Chida et al., U.S. Patent No. 4,812,698 ("Chida"); or Itsumi et al., U.S. Patent No. 5,101,278 ("Itsumi"). Finally, certain of the claims were rejected under 35 U.S.C. § 103(a) over Hathaway, Chida, or Itsumi, either alone or in view of Lazarus et al., U.S. Patent No. 5,656,882 ("Lazarus").

Applicants responded to the Office Action of September 6, 2000 on March 5, 2001. On that date, Applicants cancelled claims 1-20, and added new claims 22-33, thereby obviating the rejections under § 112, § 102, or § 103 in the September 6, 2000 Office Action.

On April 20, 2001, the Examiner mailed an Office Action stating that, "the remaining [pending] claims are not readable on the elected invention because the elected claims were drawn to an actuator constructed to assume a sigmoidal shape upon activation" and that "the new claims are drawn to a disc drive device." On October 22, 2001, Applicants amended claims 22, 32, and 33 to add language describing the actuator wherein, following activation, the actuator assumes a non-planar shape. Because of this, applicants were of the view that each independent claim, as amended, described a disk drive device including an actuator according to the elected invention.

On February 4, 2002, the Examiner mailed an Office Action stating that the Amendment filed October 22, 2001 was "non-responsive because the claims are not limited to the sigmoidal shape of the piezoelectric actuator." Accordingly, Applicants have cancelled claims 22-34 and added new claims 35-54, which recite the language of originally-elected claims 1-20 (Group I, drawn to a piezoelectric actuator, classified in class 210, subclass 328). Applicants address the outstanding rejections below as much as they may apply to the new claims. For the reasons discussed below, Applicants respectfully request reconsideration and withdrawal of the rejections made in this application.

### **1. THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

Claim 5 was rejected under 35 U.S.C. § 112, second paragraph. New claim 39 recites the language of originally-filed claim 5, except that claim 39 depends from claim 37, such that claim 39 has proper antecedent basis for the term “inactive element.” As such, Applicants respectfully request that the rejection under 35 U.S.C. § 112 be withdrawn.

### **2. THE REJECTIONS UNDER 35 U.S.C. § 102(a)**

Original claims 1-6, 8-10, and 13-17 were rejected under 35 U.S.C. § 102 over Hathaway, Chida or Itsumi. New claims 35-40, 42-44, and 47-51 recite the language of original claims 1-6, 8-10, and 13-17, and are pending for consideration.

Anticipation under 35 U.S.C. § 102 requires that a single reference teach each and every element of a claim. Any feature not directly taught must be inherently present. MPEP 706.02. Each of new claims 35-54 recite an actuator device with at least two electro-active elements and at least two conductors wherein the electro-active elements and conductors are arranged such that the actuator device forms a generally sigmoidal shape upon activation of the electro-active elements. However, none of Hathaway, Chida and Itsumi discloses an actuator device with at least two electro-active elements and at least two conductors wherein the electro-active elements and conductors are arranged such that the actuator forms a generally sigmoidal shape upon activation of the electro-active elements, as required by each of Applicants’ claims 35-40, 42-44, and 47-51 (which recite the language of original claims 1-6, 8-10, and 13-17). Therefore, Hathaway, Chida and Itsumi do not teach each and every element of Applicant’s claims. Accordingly, Applicants’ respectfully request that the rejection under 35 U.S.C. § 102 be reconsidered and withdrawn.

### **3. THE REJECTIONS UNDER 35 U.S.C. § 103**

Claims 7, 11, 12, and 18-20 were rejected under 35 U.S.C. § 103 over Hathaway, Chida or Itsumi, either alone or in view of Lazarus. New claims 41, 45, 46, 52-55 recite the language of original claims 7, 11, 12, and 18-20, and are pending for consideration.

For *prima facie* obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the

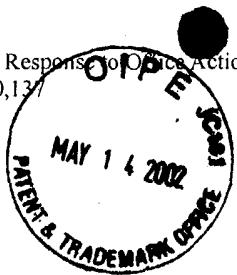
knowledge generally available in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP 706.02(j). See In re Vaeck, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The burden is expressly on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP 706.02(j). Further, when the incentive to combine the references is not immediately apparent, it is the burden of the Examiner to explain why the combination is proper. The mere fact that it is possible for two or more isolated disclosures to be combined does not render the result of that combination proper, absent a logical reason of record which justifies the combination.

In the present case, there is no showing whatsoever in the Office Action of any suggestion or motivation to combine the teachings of Hathaway, Chida or Itsumi with Lazarus. Applicants submit that that is because there is no suggestion or motivation to combine the teachings of Hathaway, Chida or Itsumi with Lazarus. Applicants respectfully submit that, without any showing whatsoever of a motivation or suggestion to combine the references, the Examiner has not met his burden in establishing obviousness, and as such, the rejection is improper and leaves the Applicants at a loss in responding.

As discussed above, Applicants submit that Hathaway, Chida and Itsumi fail to disclose every element of Applicants' claims 35-54, and the Examiner has failed to establish a suggestion or motivation to combine any of these references with Lazarus. Accordingly, Applicants request that the rejection under 35 U.S.C. § 103 be reconsidered and withdrawn.

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### CONCLUSION

Applicants respectfully request reconsideration and withdrawal of the rejections made in the Office Actions in view of the foregoing remarks. Applicants respectfully submit that pending claims 35-54 are in condition for allowance, and such action is hereby requested. If the Examiner believes that a conversation with Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to call the undersigned at the telephone number below.

A petition and requisite fee for a two-month extension of time are enclosed herewith (the two-month reply date was Saturday, May 4, 2002). The Director is hereby authorized to charge any additional fees that may be due to Deposit Account No. 20-0531.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jeremy P. Oczek".

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